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EXAMINER

COPPOLA, JACOB C

ART UNIT

PAPER NUMBER

3621

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/560,855	<b>Applicant(s)</b> YAMAMOTO ET AL.	
	<b>Examiner</b> JACOB C. COPPOLA	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 6-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgements***

1. This action is in reply to the amendments to the claims and remarks filed on 07 May 2009 (“09 May Response”), and to the amendments to the claims and remarks filed on 21 July 2009 (“09 Jul Response”).
2. Claims 6-14 are currently pending and have been examined.
3. This Office Action is given Paper No. 20091009. This Paper No. is for reference purposes only.

### ***Restrictions***

4. In light of Applicants’ cancellation of claims 1-5 (see 09 Jul Response, p. 2), the Restriction Requirement of the previous Office action mailed on 18 July 2008 is hereby withdrawn.

### ***Specification***

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP §608.01(o). Correction of the following is required:
  - a. The “prohibiting, during said reproduction of the main resource, a start of reproducing a resource that is different from the main resource being reproduced and that requires the license information for reproduction thereof” of claim 6;

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b. The “permitting, during said reproduction of the sub resource, a start of reproducing a resource that is different from the sub resource being reproduced and that requires the license information for reproduction thereof” of claim 6;

c. The “prohibits, during the reproduction of the main resource by the reproducing unit, a start of reproducing a resource that is different from the main resource being reproduced and that requires the license information for reproduction thereof” of claim 8; and

d. The “permits, during the reproduction of the sub resource by the reproducing unit, a start of reproducing a resource that is different from the sub resource being reproduced and that requires the license information for reproduction thereof” of claim 8.

### ***Claim Rejections - 35 USC §101***

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 8-14 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

### ***Regarding Claims 8-14***

7. These claims recite computer programs only. “Computer programs claimed as computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not physical ‘things.’ They are neither computer components nor statutory processes, as they are not ‘acts’ being performed.” MPEP §2106.01 I. Because the claims recite only abstractions that are neither

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“things” nor “acts,” the claims are not within one of the four statutory classes of invention<sup>1</sup>.

Because the claims are not within one of the four statutory classes of invention, the claims are rejected under 35 U.S.C. §101.

8. Additionally, the Examiner notes that using the broadest reasonable interpretation of “unit,” as noted below, the claimed units are interpreted as software only. Because the broadest reasonable interpretation of “unit” includes software only, the claims are not within one of the four statutory classes of invention and are therefore rejected under 35 U.S.C. §101.

***Claim Rejections - 35 USC §112, 1<sup>st</sup> Paragraph***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 6-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

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<sup>1</sup> 35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures, and composition of matter. The latter three categories define “things” (or products) while the first category defines “actions” (*i.e.*, inventions that consist of a series of steps or acts to be performed).

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***Regarding Claim 6***

11. Claim 6 recites “a step of (i) prohibiting, during said reproduction of the main resource, a start of reproducing a resource that is different from the main resource being reproduced and that requires the license information for reproduction thereof, and (ii) permitting, during said reproduction of the sub resource, a start of reproducing a resource that is different from the sub resource being reproduced and that requires the license information for reproduction thereof.”

12. The Examiner has carefully searched the entire specification of the original disclosure and cannot locate an adequate description for the claimed features noted above. Additionally, the features noted above are not inherent to the various components shown in the drawings.

13. Claim 8 recites similar features that cannot be found in the specification of the original disclosure. Accordingly, claim 8 is rejected in the same manner as claim 6.

***Claim Rejections - 35 USC §112, 2<sup>nd</sup> Paragraph***

14. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claim 14 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

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***Regarding Claim 14***

16. Claim 14 recites “the license managing unit updates the use state information based on a reproduction of each of the plurality of resources; and when updating the use state information, the license managing unit does not update the use state information to reflect the reproduction of the sub resource.” Claim 14 is indefinite because it is unclear how the updating is based on both the reproduction of the main and sub resources, yet the updating does not reflect the reproduction of the sub resource. This limitation is contradictory.

17. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

***Claim Rejections - 35 USC §103***

18. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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19. Claims 6, 8, 10, 11, and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Candelore et al. (U.S. 2003/0174837 A1) (“Candelore”), in view of Abecassis (U.S. 6,289,165 B1).

***Regarding Claims 6 and 8***

20. Candelore discloses:

a contents storing unit (“Computer **300**,” ¶ 0034) that stores the content data that includes a plurality of resources, the plurality of resources including at least one main resource and including at least one sub resource, the sub resource being data that is associated with the main resource and that is a different entity from that of the main resource (fig. 7 with associated text);

a license storing unit that stores license information for the content data, the license information being required for reproducing each of the main resource and the sub resource (¶¶ 0031-0032, 0108); and

a reproducing unit (“Set-top box **600**”) that reproduces at least one of the main resource and the sub resource (fig. 12 with associated text).

21. Candelore does not directly disclose:

a license managing unit that (i) prohibits, during the reproduction of the main resource by the reproducing unit, a start of reproducing a resource that is different from the main resource being reproduced and that requires the license information for reproduction thereof, and (ii) permits, during the reproduction of the sub resource by the reproducing unit, a start of reproducing a resource that is different from the sub resource being reproduced and that requires the license information for reproduction thereof.



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22. Abecassis teaches:

a license managing unit (“Multimedia Player **100**”) that (i) prohibits, during the reproduction of a main resource by a reproducing unit, a start of reproducing a resource that is different from the main resource being reproduced (the player functionality playing the content of figure 17C, particularly content outside of segments A and B, is typically limited to the main resource that is purchased (see discussion of video user selections and billing, c. 40-41; see also “video-on-demand,” at least c. 5)), and (ii) permits, during the reproduction of a sub resource by the reproducing unit, a start of reproducing a resource that is different from the sub resource being reproduced (fig. 17C with associated text (*e.g.*, switching between different camera angles)).

23. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the system of Candelore with the functionality of the managing unit of Abecassis in order to seamlessly change between available sub resources.

***Regarding Claim 10***

24. The combination of Candelore and Abecassis discloses the limitations of claim 8, as shown above, and further discloses:

the main resource includes a motion picture (Candelore, fig. 7 with associated text); and

the sub resource includes a still picture and does not include a motion picture (Candelore, fig. 7 with associated text).

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***Regarding Claim 11***

25. The combination of Candelore and Abecassis discloses the limitations of claim 8, as shown above, and further discloses:

the-sub resource includes a plurality of still pictures that are associated with the main resource and that have been encrypted (Candelore, fig. 7 with associated text);

the contents reproduction device further comprises:

a decryption unit that decrypts the plurality of still pictures collectively to generate a plurality of decrypted still pictures (fig. 12 with associated text); and

a cache unit that stores the plurality of decrypted still pictures (fig. 12 with associated text); and

the reproducing unit, when reproducing the sub resource, reads one or more still pictures from the plurality of decrypted still pictures stored in the cache unit and reproduces the read one or more still pictures (Candelore, fig. 7 with associated text).

***Regarding Claim 13***

26. The combination of Candelore and Abecassis discloses the limitations of claim 8, as shown above, and further discloses:

the plurality of still pictures are collectively compressed, and the plurality of collectively compressed still pictures are encrypted (fig. 12 with associated text); and

the decryption unit decrypts the plurality of encrypted still pictures collectively to obtain the plurality of collectively compressed still pictures, and extracts the plurality of decrypted still pictures from the plurality of compressed still pictures (fig. 12 with associated text).

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27. Claims 7, 9, and 14, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Candelore and Abecassis, in further view of Downs et al. (U.S. 6,226,618 B1) (“Downs”).

***Regarding Claims 7 and 9***

28. The combination of Candelore and Abecassis discloses the limitations of claims 6 and 8, as shown above, and further discloses the limitations:

the license managing unit permits the start of reproducing the resource that has been prohibited by the license managing unit (see Abecassis’ discussion of video user selections and billing, c. 40-41; see also “video-on-demand,” at least c. 5)

29. Candelore does not directly disclose:

the license information includes use state information indicating a use state of the content data; and

the license managing unit updates the license information to reflect the reproduction of the main resource in the use state information when the reproduction of the main resource is finished.

30. Downs teaches:

license information that includes use state information (“watermark”) indicating a use state of content data (c. 7, l. 40+); and

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a license managing unit (“End-User Player Application”) that updates the license information to reflect the reproduction of a main resource in the use state information when the reproduction of the main resource is finished (c. 7, l. 40+).

31. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include with the license information of Candelore license information of Downs, which is dynamically updated, in order to allow per-use restrictions on the content of Candelore.

***Regarding Claim 14***

32. The combination of Candelore and Abecassis discloses the limitations of claim 8, as shown above.

33. Candelore does not directly disclose:

the license information includes use state information indicating a use state of the content data;

the license managing unit updates the use state information based on a reproduction of each of the plurality of resources; and

when updating the use state information, the license managing unit does not update the use state information to reflect the reproduction of the sub resource.

34. Downs teaches:

the license information includes use state information indicating a use state of the content data (c. 7, l. 40+);

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the license managing unit updates the use state information based on a reproduction of each of the plurality of resources (c. 7, l. 40+); and

when updating the use state information, the license managing unit does not update the use state information to reflect the reproduction of the sub resource (c. 7, l. 40+, watermark of Downs can be restricted to main resource – fig. 8 with associated text – watermark process executed before being sent to “control computer 300” of Candelore; watermarked main resource combined with sub resource in “control computer 300” where both are encrypted and sent to STB).

35. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include with the license information of Candelore the license information of Downs, which is dynamically updated, in order to allow per-use restrictions on the content of Candelore. Additionally, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to only update said information for the main resource because the sub resources are often non-revenue based resources that do not require per use restrictions (*e.g.*, advertising data – Candelore, fig. 7 with associated text).

36. Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Candelore and Abecassis, in further view of Official Notice.

***Regarding Claim 12***

37. The combination of Candelore and Abecassis discloses the limitations of claim 11 as shown above.

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38. Candelore does not directly disclose wherein the decryption unit is tamper resistant.

39. However, the Examiner takes Official Notice that tamper resistant units are old and well-known in the art because they deter hackers from reverse engineering secret algorithms and discovering hardware bound keys.

40. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the decryption unit of Candelore so that it is tamper resistant, as is old and well-known in the art, in order to deter hackers from reverse engineering secret algorithms and discovering hardware bound keys within the decryption unit.

### ***Claim Interpretation***

41. After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision. See MPEP §2111.01 IV.

42. The Examiner finds that because the examined claims recite neither “step for” nor “means for,” the examined claims fail Prong (A) as set forth in MPEP §2181 I. Because the examined claims fail Prong (A) as set forth in MPEP §2181 I., the Examiner concludes that all examined claims do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

43. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his

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interpretation of the claims.<sup>2</sup> Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

- e. ***permit*** “3. To afford opportunity or possibility for.” The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000;
- f. ***prevent*** “1. To keep from happening.” The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000;
- g. ***prohibit*** “2. To prevent; preclude.” The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000;
- h. ***unit*** “(3) A software component that is not subdivided into other components.” IEEE Standard Computer Dictionary, The Institute of Electrical and Electronics Engineers, New York, NY, 1990;
- i. ***when***: “2 : in the event that: IF.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

### ***Response to Arguments***

#### ***Priority Issues***

44. Applicants argue “The Applicant submitted a copy of Form PCT/IB/304 with the present application on May 19, 2006 to demonstrate that a certified copy of the foreign priority document was received by the International Bureau.” See p. 9, 09 May Response.

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<sup>2</sup> While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

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45. The Examiner respectfully disagrees. A copy of Form PCT/IB/304 from 19 May 2006 cannot be found in the record.

***35 U.S.C. §101***

46. Applicants argue “Claims 8-13 have been amended to clarify that the claimed invention is not software, by replacing the term ‘section’ with the term ‘unit,’ and by adding a ‘contents storage unit,’ which requires more than just software alone (e.g., memory).” See p. 11, 09 May Response. The Examiner respectfully disagrees. As shown above, the term “unit,” like the term “section,” can be interpreted as meaning software *per se*. Moreover, a “contents storage unit,” in its broadest reasonable interpretation, does not require more than software. See e.g., the “secure container structure” (c. 24+) of Downs. A “contents storage unit,” in light of Downs, could be a software component data structure.

***Prior Art***

47. Applicants’ arguments with respect to claims 6-14 have been considered but are moot in view of the new grounds of rejection.

***Conclusion***

48. Applicants’ amendments filed in the 09 May Response and 09 July Response necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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49. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112, 1<sup>st</sup> paragraph written description and enablement, §112, 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103, prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

50. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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51. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure (see attached form PTO-892).

52. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

53. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/  
Patent Examiner, Art Unit 3621  
October 12, 2009

/Calvin L Hewitt II/  
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